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James Juo



10/19/06

PATENT MAINTENANCE
DIVISION

2006 OCT 25 PM 4:07

US PATENT & TRADEMARK
OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/838,330
Applicant : Marks, et al.
Filed : April 20, 2001
Title : METHOD FOR ASSEMBLY OF UNIQUE PLAYLISTS
Art Unit : 2645
Examiner : Lisa Hashem

Docket No.: : MET88-68155
Customer No. : 24201

Mail Stop 16
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REFUND

Dear Sir:

Applicant respectfully requests a refund in the amount of \$750.00 for the petition fee paid on May 6, 2005.

As noted in the communication dated October 18, 2005, from the Office of Petitions, the \$750 petition fee submitted on May 6, 2005, was not required for a reconsideration of this petition, and "is subject to a refund." A copy of this communication is attached hereto as Exhibit A.

Any request for refund must include a copy of this decision and be mailed to Mail Stop 16, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450 or faxed to the Customer Service Help Desk at (571) 273-6500.

This decision is made without prejudice to reconsideration. However, any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)" and the required reply as noted above.

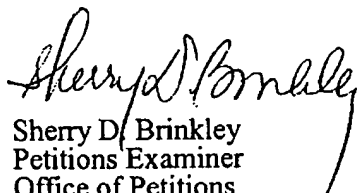
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
 Customer Service Window, Mail Stop PETITION
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204.


Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Advisory Action

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/838,330

Applicant(s)

MARKS ET AL.

Examiner

Lisa Hashem

Art Unit

2645

-The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

THE REPLY FILED 05 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 3. NOTE:

The newly amended independent claims 1, 9, 14, 16, and 20 and the newly presented claims 26 and 27 filed on 5-5-2005, raise new issues.

The newly proposed claim 1 includes the new limitation '...the user being able to send a signal to delete an undesired item playing on the base channel; upon receipt of the signal the customizer automatically plays the substitute item and creates a side channel, the side channel includes the playlist of the base channel, wherein the undesired item is absent from the playlist and a substitute item is played instead...'.

Newly proposed claim 9 includes the new limitation '...a personalized playlist of programming played on a user device with a memory resource...'.

Newly proposed claim 14 includes the new limitation '...the user device to determine in near real time which substitute items are available for use subject to at least two criteria, a first criterion comprising a style of the playlist of the base channel and a second criterion comprising a time availability of substitute items...'.

Newly proposed claim 16 includes the new limitation '...the sequence order of an item on the playlist of the base channel being identical to a sequence order of a same item or its substitute on the personalized playlist...'.

Newly proposed claim 20 includes the new limitation '...a user deletes undesired program items...' and '...an alternate personal playlist derived from the base channel...'.

Newly added claims 26 and 27 includes the new limitations: '...a method for creation of a personalized playlist of programming played on a user device, the playlist comprising sequentially played identifiable items of content from available sources of program material therein...'.

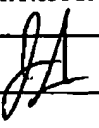
Doc Code: MET88-68155

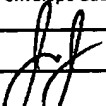
PTO/SB/21 (09-04)
Approved for use through 07/31/2008. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/838,330
	Filing Date	April 20, 2001
	First Named Inventor	Marks, et al.
	Art Unit	2645
	Examiner Name	Lisa Hashem
Total Number of Pages in This Submission	Attorney Docket Number	MET88-68155

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input checked="" type="checkbox"/> Request for Refund	Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	Remarks	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	FULWIDER PATTON LLP	
Signature		
Printed name	James Juo	
Date	10/19/06	Reg. No. 36,177

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:		
Signature		
Typed or printed name	James Juo	Date Oct 19, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



UNITED STATES PATENT AND TRADEMARK OFFICE

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20755 PLUMMER STREET
CHATSWORTH, CA 91311

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OCT 18 2005

OFFICE OF PETITIONS

In re Application of
Michael B. Marks, et al.
Application No. 09/838,330
Filed: April 20, 2001
Attorney Docket No. Box-2

ON PETITION

This is a decision in response to the communication filed May 6, 2005, which is being treated as a renewed petition under 37 CFR 1.137(b) to revive the above-identified application.

The petition is **DISMISSED**.

A grantable petition under 37 CFR 1.137(b)¹ must be accompanied by: (1) the required reply,² unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item 1.

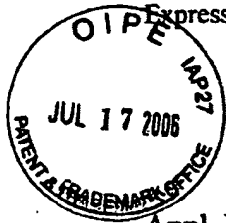
It is noted that an amendment was included with the petition filed on May 6, 2005. However, the amendment is considered non-responsive, since it did not place the application in condition for allowance. See the attached Advisory Action. The proposed reply required for consideration of a petition to revive this application must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in condition for allowance, or the filing of a submission under 37 CFR 114 (RCE) or a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2).

It is further noted that, while the requisite petition fee was paid on January 27, 2005, petitioner submitted a \$750.00 petition fee with the present petition. Since, no further petition fee is required for consideration of the present petition, the \$750.00 overpaid is subject to a refund.

¹ As amended effective December 1, 1997. See *Changes to Patent Practice and Procedure*; Final Rule Notice, 62 *Fed. Reg.* 53131, 53194-95 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* 63, 119-20 (October 21, 1997).

² In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

Express Mail No. EV 740512523 US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/838,330
Applicant : Michael B. Marks
Filed : April 20, 2001
Title : METHOD FOR ASSEMBLY OF UNIQUE PLAYLISTS
Art Unit : 2645
Examiner : Lisa Hashem

Docket No.: : MET88-68155
Customer No. : 24201

**PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION
UNDER 37 CFR § 1.137(b)**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

A Notice of Abandonment was mailed on November 4, 2005. The present application was unintentionally abandoned.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION.

The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 C.F.R. 1.137(b) was unintentional.

Applicant hereby provides the following additional information.

Until recently, this application had been prosecuted *pro se*.

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750.00 DP

132171.1

Refund Ref:
11/06/2006 ZJUHR1 0000154640 M.E.

CHECK Refund Total: \$750.00

If the Examiner has any comments or questions regarding any of the foregoing,
kindly telephone the undersigned.

Respectfully submitted,

FULWIDER PATTON LLP

By: _____

James Juo

Registration No. 36,177

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